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APR 3 0 2004

In re Application of
Kita, Yang, and Selegue
Application No. 10/692,286
Filed: October 23, 2003
Attorney Docket No. 10006.001610
For: EFFICIENT USE OF KEYFRAMES IN
VIDEO COMPRESSION

: **OFFICE OF PETITIONS**
:
: **DECISION REFUSING STATUS**
: **UNDER 37 CFR 1.47(a)**
:

This is a decision on the petition under 37 CFR 1.47(a) filed March 22, 2004.

The petition under 37 CFR 1.47(a) is **dismissed**.

Any request for reconsideration under this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Failure to respond will result in the abandonment of this application. Any response should be titled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)."

The above-identified application was filed on October 23, 2003, without a proper oath or declaration. Accordingly, a "Notice to File Missing Parts of Nonprovisional Application" was mailed on January 27, 2004, requiring payment of the filing fee, an executed oath or declaration, and a surcharge for the late filing of the oath or declaration.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor(s) cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims, and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a statement of the last known address of the non-signing inventor,

The instant petition lacks item (1) as set forth above.

As to item (1), petitioner has not established that the non-signing inventor cannot be reached or has constructively refused to sign the oath or declaration. Petitioner has only indicated that a copy of the application papers and declaration was sent to the last known address of the non-signing inventor. There is no indication that the papers were received. If petitioner is arguing that the non-signing inventor is

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unavailable to join the prosecution of the application, section 409.03(d) of the *Manual of Patent Examining Procedure* (MPEP) explains that:

[w]here inability to find or reach a non-signing inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts, which are relied on to establish that a diligent effort was made.

It cannot be concluded that petitioner made a 'diligent' effort to locate the non-signing inventor given the evidence presented. It is only clear that the application papers were sent to the last known address of the non-signing inventor; this, without more, does not amount to diligence in locating the non-signing inventor. Section 409.03(d) further explains that the aforementioned statement "... must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence, such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the non-signing inventor could not be found or reached should be made part of the statement." In this case, petitioner should, at least, provide some evidence that the non-signing inventor has received the application papers, i.e., a certified mail return receipt, or that other efforts were made to locate the non-signing inventor to no avail.

If petitioner is maintaining that the non-signing inventor has constructively refused to join the application, petitioner must provide some evidence that the non-signing inventor has received the application papers, but is unwilling to comply as demonstrated by inventor's behavior either expressly or constructively.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
Commissioner for Patents,
PO Box 1450
Alexandria, VA 22313-1450

By FAX: (703) 872-9306
Attn: Office of Petitions

Telephone inquiries should be directed to the undersigned (703) 305-0010.



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